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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,613

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Marc Peuker

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EXAMINER

PAGAN, JENINE MARIE

ART UNIT

PAPER NUMBER

3728

NOTIFICATION DATE

DELIVERY MODE

11/15/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/598,613	Applicant(s) PEUKER ET AL.	
	Examiner JENINE M. PAGAN	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 11-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed on 8/27/2010. Claims 1-25 are pending in the application. Claims 26 are cancelled. Claims 11-19 are withdrawn from consideration.

The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the separation wall as described in the specification and the claims. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are

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not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-3, 6 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 and 3 recites the limitation "radially extending through-hole" in each claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear to the examiner if the Applicant is claiming the through-hole itself is radial or if the through-hole is radially extending around the application member. Claim 2 and 3 recites the limitation "said dental materials" in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. The dental materials are not positively claimed. Claim 6 is rejected due to its dependency on claim 3.

Claim Rejections - 35 USC § 102

5. Claims 1-4, 8, 20-21 and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Pierick US 3,279,654.

Claim 1 and 25: Pierick discloses a capsule for storage and mixing and dispensing of material comprising a capsule body member 11 providing a main

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chamber (see figure above), and comprising a dispensing opening (see figure above), and wherein the inner wall 22 of the capsule body member comprises a recessed area 26;

an applicator member 16 being slideably accommodated in said capsule body member 11, said applicator member 16 providing an auxiliary chamber (see figure above), and wherein said applicator member 16 comprises a through-hole 34/35/36 extending from the auxiliary chamber to the outer circumferential surface of the applicator member; and an activator member 19 being slideably accommodated in said applicator member 16; said through-hole 34/35/36 and said recessed area 26 forming a channel between said main chamber and said auxiliary chamber upon activation of said capsule by said activator member (Col 3:46-50); said main chamber and said auxiliary chamber being selectively connectable for fluid communication between said chambers upon activation of said capsule by said activator member 19, wherein movement of said activator member 19 towards said dispensing opening causes movement of said applicator member 16 so that said channel between said main chamber and said auxiliary chamber is formed.

(When a substance is inserted into the auxiliary chamber and the activator member slides into the application member 16, it will cause pressure to slide the application member toward the main chamber.

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Claim 2: Pierick discloses radially extending through-hole 34/35/36 in said applicator member 16 is initially covered by the wall 22 of said capsule body member 11. (Col 3:20-27)

Claim 3: Pierick discloses said radially extending through-hole 34/35/36 is located in close proximity to the separation wall 17 of said applicator member 16 separating said auxiliary chamber from said mixing chamber.

Claim 4: Pierick discloses said through-hole 34/35/36 extends essentially perpendicularly to the longitudinal axis of said applicator member 16.

Claim 8: Pierick discloses said applicator member 16 comprises a sealing element 32/33 sealing said through-hole 34/35/36 of said applicator member 16 against said recessed area 26 of said body member 11 and against the exterior of said capsule.

Claim 20: Pierick discloses a dispensing cannula 13 connected to said dispensing opening.

Claim 21: Pierick discloses the dispensing cannula 13 is integrally formed with said capsule body member 11.

Claim 24: Pierick discloses said main chamber contains a first, preferably powdery, component of said material 29 (Col 2:67-72), and said auxiliary chamber contains a second, preferably liquid, component of said material 37 (Col 3:20-27).

Claim Rejections - 35 USC § 103

6. Claims 5-7, 9 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierick US 3,279,654 in view of Fukui et al. US 6,544,233.

Claim 5: Pierick discloses said through-hole 34/35/36 extends essentially at an angle to the longitudinal axis of said applicator member 16 but it does not specifically disclose the angle being smaller than 90°.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the angle be smaller than 90°, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 6 and 7: Pierick discloses a separation wall but it does not specifically disclose the separation wall comprise a raised area extending towards said activator member comprising an annular bulge.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the separation wall of Pierick to include a raised portion with an annular bulge since it was known in the art that doing so would create an area to allow mixing of the two components.

Claim 9: Pierick discloses an activator member but it does not specifically disclose the activator member comprising an activator sealing element for sealing the activator member against the applicator member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the activation member of Pierick to include a sealing element since it was known in the art that doing so would prevent articles from spilling out of the application member.

Claim 22: Pierick discloses a cannula but it does not specifically disclose the cannula is rotatably connected to the capsule body member thus providing a valve.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the cannula be rotatably connected to the capsule body member since it was known in the art that would allow various types of cannulas to be used for the capsule such as a needle type or a regular nozzle type.

Claim 23: Pierick discloses holding various materials but it does not specifically disclose dental materials are glass ionomer cements or resin modified glass ionomer cements.

To have the capsule of Pierick hold the specified dental materials is considered to be intended use and the capsule of Pierick is capable of holding such materials. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Response to Arguments

7. Applicant's arguments, see Amendment, filed 8/27/2010, with respect to the rejection(s) of claim(s) 1-10 and 20-25 under 103(a) with the reference Schwartz have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Pierick.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENINE M. PAGAN whose telephone number is (571)270-3216. The examiner can normally be reached on Monday - Thursday, 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mickey Yu/
Supervisory Patent Examiner, Art Unit 3728

/Jenine M Pagan/
Examiner, Art Unit 3728